

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Amendment, claims 1-3 have been amended. Also, claims 4-6 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 1-3 and 7-8 are pending in the present application.

No new matter has been added by way of these amendments. For instance, Applicants note page 8, line 7 and Example 2 (for claims 1 and 3) and page 13, lines 3-4 (for claim 2) of the present specification.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, Second Paragraph

Claims 1-3, 7 and 8 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite (see paragraphs 1-3 of the Office Action). Applicants respectfully traverse.

Applicants respectfully refer the Examiner to claims 1 and 3 as shown herein. The "iron salt" has been further defined such that there is no inconsistency in the claims. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Misaki '996 (U.S. Patent No. 4,765,996) in view of Kwak '997 (U.S. Patent No. 6,402,997) (see paragraphs 4-15 of the Office Action). Applicants respectfully traverse and reconsideration is based on the following remarks.

Applicants respectfully refer the Examiner to the claims as shown herein. The pending claims now recite that the iron salt has an average particle diameter of 0.05 to 0.8 μm (claims 1 and 3) or the range of 0.05 to 0.5 μm (claim 2).

In this regard, the cited Misaki '996 reference fails to disclose or suggest the enriched rice or barley having an emulsifying agent-coated iron salt composition, wherein the iron salt has an average particle diameter of 0.05-0.8 μm or 0.05-0.5 μm as instantly claimed. As the M.P.E.P. directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* M.P.E.P. § 2143.03. Further, the cited Kwak '997 reference merely discloses a particle size that is 2-5 microns in diameter. Thus, Kwak '997 does not account for the deficiencies of the primary reference.

Additionally, Applicants note that in the case that an average particle diameter of the iron salt is more than 2 μm , rice or barley of which surface is uniformly coated cannot be obtained (see the present specification at page 8, lines 15-18). Thus, the present invention has unexpected advantages with the recited ranges.

Also regarding unexpected results for the present invention, Applicants (again) respectfully refer the Examiner to the previously submitted Declaration pursuant to 37 C.F.R.

§ 1.132 by co-inventor Noboru SAKAGUCHI as being applicable to the claims as instantly amended. Still, while Applicants appreciate the withdrawal of the anticipation rejection (see paragraph 18 of the Office Action), the Examiner states that the unexpected results of the previously submitted Rule 132 Declaration do not overcome the obviousness rejection because the Declaration is essentially directed to processes and the results in Tables 1-3 reflect the results of those processes. Also, the Examiner states that the values are not recited in the claims and thus the Rule 132 Declaration is not commensurate in scope with the claims. Applicants respectfully reconsideration.

The Examiner is respectfully reminded of the legal precedent, *In re Merchant*, 197 U.S.P.Q. 785, 788 (C.C.P.A. 1978), concerning objective evidence, as follows (*emphasis added*):

Finally, the solicitor repeats the objection voiced by the examiner that the declaration is irrelevant because the claims specify neither the unexpected result nor the "features" that produce that result. *We are aware of no law requiring that unexpected results relied upon for patentability be recited in the claims.* The "features" referred to by the examiner are the conditions of pressure, feed rate, and reactor retention time for the commercial operation described in the declaration. We are equally unaware of any law requiring that commercial production parameters be claimed. Moreover, the "feature" responsible for appellant's unexpected results is recited in the claims, viz., "substantially anhydrous."

(Applicants' emphasis added.)

The submitted Rule 132 Declaration shows the features of the products themselves because the measured properties (e.g., final vitamin and mineral content) are those of the products. Further, the experimental results in the Rule 132 Declaration do not have to be recited in the claims. The products having the emulsifying agent-coated iron salt are being claimed, and the experimental results show that the claimed products achieve better retention of vitamins and

minerals while exhibiting improved storage stability. The excellent effects are obtained because a reaction generated by a direct contact of iron and vitamins is controlled in the present invention by using an emulsifying agent-coated iron salt composition. Thus, the Rule 132 Declaration is proper and sufficient to show patentability for the claimed invention.

Applicants also note that the Misaki '996 embodiment (e.g., see Enriched Rice 1 or 2 of the Rule 132 Declaration) leads to higher losses of vitamins and minerals, whether such losses are measured when the product was made, after washing, and after storage for one month. And again, Misaki '996 is prepared using iron alone.

Accordingly, reconsideration of the evidence of record is respectfully requested.

Based on the above and the evidence of record, Applicants respectfully submit that a proper weighing of the *Graham* factors, including ascertaining the differences between the prior art and the claims that are at issue and any evidence of secondary considerations, resides in Applicants' favor. *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Application No. 10/542,200
Art Unit 1794
Reply to Office Action of June 17, 2009

Docket No.: 1422-0683PUS1

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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